



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kyung Shig CHUNG

Serial No. 10/724,059

Group Art Unit: 2854

Confirmation No. 1727

Filed: December 1, 2003

Examiner: Dave A. Ghatt

For: PAPER GUIDE AND ELECTROPHOTGRAPHIC FORMING APPARATUS HAVING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, Virginia 22313-1450

Sir:

This is responsive to the Office Action mailed November 16, 2004, having a shortened period for response set to expire on December 16, 2004, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR § 1.142

Applicants provisionally elect **Group I, claims 1-17 and 20-23** in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 18 and 19 are so closely related to elected claims 1-17 and 20-23 that they should remain in the same application. The elected claims 1-17 and 20-23 are directed to a paper guide of an electrophotographic image forming apparatus and an electrophotographic image forming apparatus, respectively; and claims 18 and 19 are drawn to a method of printing an image on a printing paper in an electrophotographic image forming apparatus. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims of similar varying scope in the same field of technology. While it is noted that the Examiner has identified different classifications for the two groups of claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the

Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP § 803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims is directed to printing an image on a printing paper in an electrophotographic image forming apparatus, and elected claims 1-17 and 20-23 are directed to a paper guide of an electrophotographic image forming apparatus and an electrophotographic image forming apparatus, respectively, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Dec 1, 2004

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